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| 10/699,595      | 10/31/2003  | Howard M. Thomson    | 58584.US/1458.7     | 1884             |

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| EXAMINER |
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WRIGHT, ANDREW D

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3617

DATE MAILED: 08/10/2005

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**AUG 10 2005**

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/699,595  
Filing Date: October 31, 2003  
Appellant(s): THOMSON, HOWARD M.

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Robert O. Fox  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/19/2005.

A

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is substantially correct. With respect to claims 1, 2, 4, and 6-7, the appellant's statement of the grounds of rejection is correct. With respect to claims 3, 5, and 8, the appellant's statement is substantially correct, except that a new ground of rejection is being added based upon

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appellant's arguments that were made for the first time in the appeal brief. The new ground of rejection is listed below.

**NEW GROUND (S) OF REJECTION**

Claims 3, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192), Shorter (US 3,967,569) and Robinson (US 6,035,797).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

|                   |               |         |
|-------------------|---------------|---------|
| US Pat. 3,779,192 | Gonzalez      | 12-1973 |
| US Pat. 3,799,093 | Thomson       | 3-1974  |
| US Pat. 3,967,569 | Shorter, Jr.  | 7-1976  |
| US Pat. 6,035,797 | Robinson      | 3-2000  |
| US Pat. 6,450,737 | Rytand et al. | 9-2002  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, and 6-7 are rejected under 35 USC 103(a). This rejection is set forth in the Office Action mailed on 10/25/04.

Claims 3, 5, and 8 are rejected under 35 USC 103(a). This rejection is set forth in the Office Action mailed on 10/25/04.

Claims 3, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192) and Shorter (US 3,967,569) as applied to claims 1, 4, and 6 (in the Office Action of 10/25/04), and further in view of Robinson (US 6,035,797). Thomson in view of Gonzalez and Shorter contains all of the elements of claims 3, 5, and 8 except for the vent. Robinson shows a float unit that has a foam core. Robinson discloses that a vent (140) is provided in the top surface of the float unit (see figs. 1-6, and lines 12-34 of column 9). Robison teaches that the vent is used to allow the escape of gasses that build up in the foam core due to natural heating of the foam. Robinson teaches that the build up of gasses in a foam core is a known problem (see lines 50-67 of column 3). The vent (140) acts as a one-way valve and allows gasses to escape, but prevents the ingress of water. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Thomson by adding the vent disclose by

Robinson. The motivation would be to allow the natural build up of gasses in the foam core to vent away from the foam core as taught by Robinson. This new ground of rejection is made in addition to the pending rejection of claims 3, 5, and 8, and in response to arguments that appellant made for the first time in the Appeal Brief after the close of prosecution.

#### **(10) Response to Argument**

Appellant argues that hindsight reconstruction is impermissible (Brief, page 5). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues that the 103 rejection is improper because Shorter does not attribute any negative to the development of cracks (Brief, page 6). In response it is noted that Shorter is not being used to show a negative impact of the cracking concrete. Shorter is used by the examiner solely to show that concrete in the concrete dock sections is susceptible to cracking and thereby exposing the core to water. Gonzalez, not Shorter, teaches why exposure of the foam is detrimental. Gonzalez teaches that

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"the blocks of Styrofoam are coated ... with a suitable film ... which prevents attack by acids, corrosives, detergents, organic solvents, and the like" (see Gonzalez, lines 18-21 of column 4). Gonzalez also teaches that "blocks of ... foam are coated ... by a protective film or cover which is waterproof and impervious to most corrosives, acids, detergents, and organic solvents" (Gonzalez, lines 44-59 of column 5). Thus, Shorter is not being used to show a negative effect of having foam exposed because Gonzalez shows that. Therefore, appellant's argument that the combination is improper because Shorter doesn't show any negative effect of cracking concrete is no persuasive.

Appellant argues that the reliance on "common knowledge" is improper (Brief, page 6). In response, it is first noted that appellant is arguing against the examiner's "Response to Arguments" and not the rejection itself. Secondly, it is noted that the rejection is not based upon an unsupported assertion of "common knowledge". Rather, Shorter is used to show that cracking concrete is known. Thus the rejection based upon information in the prior art. In other words, a prior art reference is provided to prove the existence of the common knowledge. Appellant further argues that the examiner must point to concrete evidence in the record to support his findings (Brief, page 6). In response it is noted that the use of the Shorter reference does exactly that: provides teaching and disclosure in the prior art to support the examiner's statement that it is known that concrete is susceptible to cracking. Furthermore, while it is on the record but is not used in the rejection of claims 1, 2, 4, 6, and 7, the Rytand et al. (US 6,450,737) reference provides further support for the examiner's position. Rytand

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teaches that floats made with concrete are vulnerable to freeze-thaw deterioration where water enters superficial cracks and then freezes to form larger cracks (See Rytand, line 63 of column 1 through line 6 of column 2). Thus there are two prior art references on the record that demonstrate that it is known that concrete may crack. Therefore, appellant's argument is not persuasive.

Appellant argues that the 103 rejection of claims 3, 5, and 8 is improper (Brief, page 7). Appellant argues that Rytand does not show a vent extending into the core. Appellant argues that the bottom of Rytand is open to atmosphere and there is no need for a vent. It is noted that Rytand shows cable chases that comprise holes formed through the foam core of a float unit. The chases extend from the core to atmosphere. The chases are used to route utility lines (such as electrical cords) below the deck level so that the walking deck is not cluttered with utility lines. It is asserted in the rejection that it would be obvious to further modify Thomson by adding such chases. Appellant does not contend this assertion. It is asserted in the rejection that such chases would inherently function as a vent as recited in claims 3, 5, and 8. The rejection does not assert that Rytand needs a vent or that Rytand uses the chases to act as a vent, as appellant appears to argue. The rejection merely asserts that it would be obvious to add the chases to Thomson, and that such chases would read on the recited limitations of claims 3, 5, and 8, regardless of whether it is called a "chase" or a "vent". Therefore, appellant's argument is not persuasive.



For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

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reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Andrew Wright

*AW 8/4/05*

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Robert Oberleitner

Conferees:

Samuel Morano

*SM 8/5/05*

Ed Swinehart

*ES 8/4/05*

*approved  
Robert Oberleitner  
8/8/05*